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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,093	04/01/2004	Derek Wyatt	3084.EEM	9478

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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02/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,093	Applicant(s) WYATT, DEREK	
	Examiner CHRISTOPHER P. BRUENJES	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al (WO 91/01711 A1) in view of Okamoto et al (JP 08-057051 A).

Hull et al teach a method for storing adhesive compositions (p.1, 1.2-4). The limitations that the method is “for reducing freeze/thaw voids in an uncured adhesive” and “that the thawed uncured adhesive contains fewer freeze-thaw voids than would be contained in an adhesive frozen and thawed in a container not meeting the limitations of (a)(i), and (ii) or (iii)” are not manipulative steps. The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. However, when the claim recites using an old composition or structure and the “use” is directed to a result or property of that composition or structure, then the claim is anticipated. These two limitations are not providing new manipulative steps and the limitations are direct results of the property of that composition or structure so because Hull and Okamoto teach the manipulative steps claimed it meets the limitations in the same manner as the claimed invention and the mere recitation of a direct result of the known method steps and structure of the container does not provide a patentable difference. The method includes filling a container with an uncured adhesive, freezing the adhesive within the container and storing the adhesive while frozen and thawing the uncured adhesive prior to use (p.3, 1.26 – p.4, 1.6). The container is formed of a thermoplastic material (p.5, 1.1-8). The thermoplastic material is polypropylene (p.6, 1.35-36), which is injection moldable and has a flexural modulus of less than or equal to 1240MPa. The container has a thickness of approximately 0.035 inches (0.899mm) based on calculations of the inner diameter to the outer diameter of the container of example 1 (p.6, 1.35-36).

Hull et al fail to teach that the wall of the container is roughened to have a mean roughness value of greater than 0.3 micrometers. However, Okamoto et al teach that the inner surface of the wall of a syringe is roughened in order to decrease the sliding friction between the

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gasket of the plunger and the syringe outer wall so that the material within the syringe can more easily be dispensed from the syringe (p.1-2, paragraphs 3 and 4 and p.3, paragraph 15 of new machine translation). Okamoto et al teach that the optimal mean roughness value of the inner surface of the syringe is 0.5 to 5 micrometers (p.3, paragraph 15 of new machine translation), which is greater than 0.3 micrometers. Okamoto et al further teach that the roughness is formed by mechanical abrasion such as sandpaper processing (p.3, paragraph 15 of new machine translation). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to roughen the inner surface of the wall of a syringe in order to decrease the sliding friction between the gasket of the plunger and the syringe wall, which will enable the composition held in the syringe to be more easily dispensed, as taught by Okamoto et al.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to roughen the inner surface of the syringe of Hull et al by mechanical abrasion or sandpaper processing to have a mean roughness value greater than 0.3 micrometers, in order to improve the dispensability of the adhesive stored in the syringe by decreasing the sliding friction between the gasket of the plunger and the syringe wall, as taught by Okamoto et al.

Regarding claim 16, the container is a syringe (p.5, l.31).

Response to Arguments

5. Applicant's arguments filed February 4, 2008 have been fully considered but they are not persuasive.

In response to Applicant's arguments regarding Van Dyke, Bergner, and Batson, these references have not been relied upon to reject claims 14-16.

In response to Applicant's argument that the method of Hull is different then the method of the instant invention, the method of Hull meets all of the limitations of the claimed method. The fact that Hull teaches additional steps in the process that are not claimed by applicant does not affect whether Hull teaches the claimed limitations. The claim is written in open language so the scope of the claim includes extra steps that are not specifically claimed.

In response to Applicant's argument that Hull does not teach that the container is flexible or thin walled. First, flexible is not a limitation in the claim. Second, Hull teaches that the container has a wall thickness of 0.035 inches, which is a thin walled container in the same manner the claimed invention is considered thin walled with the same thickness value. Furthermore, although a thin glass container might not be flexible would not mean that Hull only desires a container that does not contain any flexibility. Especially in light of the fact Hull teaches forming the container from the same plastic material as claimed in the same thickness as claimed.

In response to Applicant's argument that Okamoto does not teach a material having the claimed flexural modulus, Okamoto was not relied upon in the rejection to teach the flexural modulus. The syringe of Hull is formed of polypropylene, which has the claimed flexural modulus.

In response to Applicant's argument that Okamoto teaches a certain way of roughening so that the roughened edges are obtuse angles to reduce sliding friction, the claims do not define a method of roughening or the shape of the roughness on the container they merely define that there is a roughness. Regardless of how Okamoto obtains a roughness it is a roughness so it provides a teaching for the claimed limitation of the container having a mean roughness value of greater than 0.3 micrometers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER P. BRUENJES whose telephone number is (571)272-1489. The examiner can normally be reached on Monday thru Friday from 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher P Bruenjes
Examiner
Art Unit 1794

/Christopher P Bruenjes/
Examiner, Art Unit 1794
February 15, 2008